

### **Remarks**

The following remarks are submitted to be fully responsive to the Final Office Action dated August 4, 2004. It is further submitted that this response is timely filed within the three-month shortened statutory period. Accordingly, no fee is believed necessary. Should any fee be required, the Commissioner is authorized to charge Kagan Binder Deposit Account No. 50-1775 and thereafter notify us of the same. Reconsideration of all outstanding grounds of the rejection and allowance of the subject application are believed in order and respectfully requested.

Independent claims 63 and 65 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,527,342 to Pietrzak et al. in view of International PCT Application No. WO 97/47246 to Sohn et al. In particular, the Official Action takes the position that while Pietrzak et al. does not teach a detachable tip for a needle that has a flexible extension of the tip opposite a sharp end of the detachable tip as recited in independent claims 63 and 65, it would have been obvious to modify Pietrzak et al. as based on the teaching of Sohn et al. to provide such a flexible extension. The Official Action additionally notes that Pietrzak et al. does not teach a detachable tip for a needle that is adapted for being grasped by a nonsolid needle at a side of such an extension of the detachable tip (claim 63) or at a side opposite the extension (claim 65). Regarding these deficiencies of the Pietrzak et al. reference, the Official Action also takes the position that it would have been obvious to modify Pietrzak et al. as based on the teaching of Sohn et al. to provide the detachable tip as claimed in independent claims 63 and 65.

Applicants respectfully traverse the rejection. Pietrzak et al. provides a suture anchor that is forcefully driven with a driver instrument to be permanently implanted in a bone. A suture can then be attached to the implanted suture anchor to attach the suture to the bone via the suture anchor. As explained in the Pietrzak et al. reference, the suture anchor is formed from a metallic material possessing sufficient strength to penetrate the bone.

While the Sohn et al. reference is also directed to attaching sutures to bones, it does so in an entirely different functional manner from the Pietrzak et al. reference. In particular, Sohn et al. attaches a suture directly to a bone by threading the suture through a curved channel formed in the bone. In particular, the way in which Sohn et al. attaches

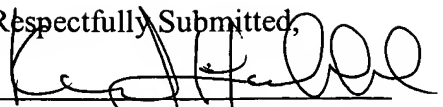
a suture directly to a bone can best be explained with reference to Figure 3 of the Sohn et al. reference. Figure 3A shows a superelastic needle positioned in a gun. The needle normally has a curved shape. However, when positioned in the gun, the needle is elastically forced to be generally straight. As the needle is ejected from the gun, the needle resumes its normal curved shape because of its superelasticity and thereby forms a curved channel in the bone as can be seen in Figure 3B. As the needle passes through the bone it also threads a suture through the channel that is being formed in the bone as shown in Figure 3C.

In all of the embodiments described in the Sohn et al. reference, the reason that the needle has a superelastic flexibility is for the purpose of forming a curved channel in the bone. One skilled in the art would not modify the suture anchor of Pietrzak et al. to have a flexible extension as based on the teaching of the Sohn et al. reference. One skilled in the art would have no motivation to modify the rigid suture anchor of Pietrzak et al. to include a flexible portion because the suture anchor of Pietrzak et al. is not intended to be used for any other purpose than to be driven into a bone for providing an attachment point for a suture. The suture anchor of Prietrzak et al. is specifically designed to engage with a bone for permanent implantation therein. Moreover, one skilled in the art would not modify the suture anchor of Pietrzak et al. to be grasped by a nonsolid needle. This is also because the suture anchor of Pietrzak et al. is not intended to be used for any other purpose than to be driven into a bone for providing an attachment point for a suture. Thus, the proposed modification would not have been apparent to one skilled in the art and withdrawal of the rejection of record is respectfully requested.

For at least these reasons, Applicants respectfully submit that the suture anchor of Pietrzak et al. cannot be modified as based on Sohn et al. to include a flexible portion as recited in independent claims 63 and 65. Accordingly, withdrawal of the rejection of record and allowance of independent claims 63 and 65 is respectfully requested.

In view of the above remarks, it is respectfully submitted that the claims and the present application are now in condition for allowance, which allowance is earnestly solicited. In the event that a phone conference between the Examiner and the Applicant's undersigned attorney would help resolve any remaining issues in the application, the Examiner is invited to contact the undersigned as set out below.

Dated: 4 OCT 04

Respectfully Submitted,  
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